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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-984

MARY HELEN SEARS,
Petitioner,

v.

ROBERT GOTTSCHALK, Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

EDWARD S. IRONS
1801 K Street, N.W.
Washington, D.C. 20006
296-8855
Attorney for Petitioner

WILSON - EPES PRINTING CO., INC. - RE 7-6002 - WASHINGTON, D. C. 20001

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Fourth Circuit entered in this proceeding on December 15, 1975.

THE OPINIONS BELOW

The opinion of the district court is unreported and is reproduced in Appendix A, *infra*, p. 1a. The opinion of the court of appeals is unreported and is reproduced in Appendix A, *infra*, p. 2a.

JURISDICTION

The opinion of the Court of Appeals for the Fourth Circuit was filed on December 15, 1975. This petition for writ of certiorari was filed within 90 days of that date. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTES AND PATENT OFFICE RULES INVOLVED

5 U.S.C. § 552(a)(3) and (b)(3):

> "Section 552. *Public Information; agency rules, opinions, orders, records and proceedings.*
>
> "(a) Each agency shall make available to the public information as follows:
>
> • • • •
>
> "(3) Except with respect to the records made available under paragraphs (1) and (2) of this subsection, each agency, upon any request for records which (A) reasonably describes such records and (B) is made in accordance with published rules stating the time, place, fees (if any), and procedures to be followed, shall make the records promptly available to any person.
>
> • • • •
>
> "(b) This section does not apply to matters that are—
>
> • • • •
>
> "(3) specifically exempted from disclosure by statute."

Section 552 was amended by the 1974 Amendments to the FOIA Act, Pub.L. 93-502, 88 Stat. 1561. Prior to the amendments, § 552(a)(3) read, in pertinent part:

> "Except with respect to the records made available under paragraphs (1) and (2) of this subsection,

> each agency, on request for identifiable records made in accordance with published rules stating the time, place, fees to the extent authorized by statute, and procedure to be followed, shall make the records promptly available to any person. . . ."

The amendments did not affect exemption 3 of the Act, 5 U.S.C. § 552(b)(3) [5 USC § 552(b)(3)].

35 U.S.C. § 103:

> **"Conditions for patentability; non-obvious subject matter**
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

35 U.S.C. § 122:

> **"Confidential status of applications**
>
> Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

35 U.S.C. § 131:

> **"Examination of application**
>
> The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that

the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor."

35 U.S.C. § 282:

"Presumption of validity; defenses

"A patent shall be presumed valid. . . ."

QUESTIONS PRESENTED

1. Is appellate leave required to vest jurisdiction in the district court to consider a motion under Rule 60(b) for relief from the judgment after the court of appeals has finished with the case?

2. Under the rule in *Administrator, FAA* v. *Robertson*, 422 U.S. 255 (1975) which requires the Freedom of Information Act (FOIA) and the various statutes restricting disclosure to be construed, whenever possible, so as "to regard each as effective", must 35 U.S.C. § 122 be so construed that "applications necessary to carry out the provisions of any Act of Congress" are subject to the mandatory disclosure provisions of the FOIA?

3. Is unpublished evidence properly considered on the issue of patentability under 35 U.S.C. § 103 as is the practice in the federal courts or is such unpublished evidence properly ignored in accordance with the practice of the Patent Office in examining pending patent applications under 35 U.S.C. § 131?

STATEMENT OF THE CASE

This is a Freedom of Information Act (FOIA) case. The original judgment in this case was filed April 16, 1973. See *Sears* v. *Gottschalk*, 357 F.Supp. 1327. The Fourth Circuit affirmed on August 14, 1974, 502 F.2d 122. A petition for writ of certiorari, No. 74-584, was timely filed and pended in this Court concurrently with

the petition in No. 74-450, *Administrator, FAA* v. *Robertson*. The petition in No. 74-450 presented a single broad question as to the scope of exemption 3 [5 USC § 552 (b)(3)] of the FOIA. The petition in this case, No. 74-584, presented an identical question "1" plus additional questions which the petition in No. 74-450 did not raise.

The certiorari petition in No. 74-450 was granted on December 19, 1974, 419 U.S. 1067. Various motions for briefing and argument of No. 74-584 in tandem with No. 74-450 were denied. *Robertson* was decided on June 24, 1975, 422 U.S. 255. On June 30, 1975, the petition in No. 74-584 was denied —— U.S. ——, 45 L.Ed.2d 709.

A timely petition for rehearing was filed emphasizing that the decision of the Court of Appeals in this case is in conflict with this Court's ruling in *Robertson*. The rehearing petition was denied on October 6, 1975, —— U.S. ——, 46 L.Ed.2d 116.

On October 28, 1975, petitioner filed a "Motion Pursuant to Rule 60(b)(6) for Relief From Judgment" in the district court. The motion urges that the decisions of the district court and of the court of appeals in this case are in conflict with the law as explicated by this Court in *Robertson* and hence that the judgment should be vacated. The motion specifically emphasizes that, in *Robertson* this Court determined that the FOIA and § 1104 of the FAA Act are "capable of coexistence" and that the courts are therefore under a "duty . . . to regard each as effective". 422 U.S. 255, 257, 45 L.Ed.2d 170, 173.

The petitioners' Rule 60(b)(6) motion points out that the decision of the district court in *this* case—as affirmed on appeal:

". . . fails to give effect to important parts of both the FOIA and 35 U.S.C. § 122, notwithstanding the fact that these two statutes are clearly capable of coexistence. Instead of discharging the courts' 'duty . . . to regard each as effective', [the] judgment holds that exemption 3 repeals by implication that provision of § 122 that mandates public availability of 'applications for patents' that are 'necessary to carry out the provisions of any act of Congress'.

"2. One of the 'two aspects' of the FOIA 'seeks to open public records to greater public access',[2] while 'the other . . . seeks to preserve the confidentiality undeniably essential in certain areas of Government operations'.[3] Robertson *supra* 45 L.Ed.2d at 170-171.

"Section 122 has two like aspects. In one, it seeks to open to the public those patent applications as to which exclusion from 'confidence' is 'necessary to carry out any Act of Congress'; in the other, it seeks to preserve in confidence all applications not so 'necessary' and as to which the Commissioner has not determined that 'special circumstances' warrant disclosure.

* * * *

"The disclosure aspect of § 122 is concerned with those applications 'necessary to carry out the provisions of any Act of Congress'. The applications in this category are expressly excluded from its 'confidence provisions' by § 122's own terms. 'The wisdom of the balance struck by Congress is not open to judicial scrutiny.' Robertson, *supra*, 45 L.Ed.2d at 174.

"These records, accordingly, cannot be subjected to exemption 3. Instead, the disclosure provisions of

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"[2] I.e., the disclosure provisions of § 552(a).

"[3] I.e., by the 'nine explicitly exclusive exemptions', 45 L.Ed.2d at 171."

the FOIA, § 552(a), apply directly to require that all such applications be 'produced on demand'. NLRB v. Sears, Roebuck & Co., 421 U.S. 132, 44 L.Ed.2d 29, 45 (1975). (Footnote omitted)

* * * *

". . . [B]oth aspects of § 122 and *both* aspects of the FOIA are clearly 'capable of coexistence'.

"Specifically, the nondisclosure, or exemption 3, aspect of the FOIA, applies only to those applications which § 122 gives the Commissioner discretion *not* to disclose, whereas the *disclosure* aspect of the FOIA, § 552(a), applies to 'necessary applications' as to which the Commissioner *has no* such discretion'.

The petitioner's Rule 60(b)(6) motion further demonstrates that the requested records are "necessary to carry out the provisions of any Act of Congress"—for example the application by the Patent Office and the courts of the constitutional patentability standard pursuant to 35 U.S.C. § 103. Consideration of the evidence contained in these records is "necessary" to the Commissioner's discharge of his duty under 35 U.S.C. § 131 to "cause an examination to be made of the application and the alleged new invention; *and if on such examination it appears that the applicant is entitled to a patent under the law*, the Commissioner shall issue a patent therefor."

The Rule 60(b)(6) motion also points out that whereas *nonpublic* evidence—including but not limited to abandoned patent applications—is routinely considered on the issues of patentability *in the federal courts*,[1] *the Patent Office* flatly refuses to consider such evidence.

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[1] Citing as to abandoned patent applications *Brown* v. *Guild*, 90 U.S. 181 (1874) (abandoned applications have a bearing on the question of invention or discovery and hence are properly included in "the whole of the evidence" germane to patent validity); *Brown* v. *Davis*, 116 U.S. 237 (1886); *Yale Lock Mfg. Co.* v. *Greenleaf*,

Thus the Patent Office disclaims the admonition in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) that the Commissioner shall "*adhere strictly* to the 1952 act as interpreted here", 383 U.S. at 18. —and so perpetuates the dichotomy between administrative and judicial patentability standards which this Court has twice condemned. *Graham, supra* 383 U.S. at 18-19; *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470 (1974).

On November 14, 1975, the district court denied the Rule 60(b)(6) motion stating

> "I don't think I have jurisdiction; I think it's improperly filed. I'll dismiss it for that reason." (App. 1a)

On December 1, 1975, petitioner filed in the Fourth Circuit Court of Appeals a "Petition to Permit the District Court to consider Motion Pursuant to Rule 60(b)(6)," noting, *inter alia*

> "There is a conflict in the circuits as to whether appellate leave is required before the District Court

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117 U.S. 554 (1886); *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U.S. 477, 484 (1935); *Smith* v. *Hall*, 301 U.S. 216 (1937) (unpublished abandoned patent application "is competent and cogent evidence to determine the nature and date of the invention"). *Package Devices, Inc.* v. *Sun Ray Drug Co.*, 301 F. Supp. 768 (E.D. Pa. 1969), aff'd 432 F.2d 272 (3 Cir. 1970); *James B. Clow & Sons, Inc.* v. *United States Pipe & Foundry Co.*, 313 F.2d 46 (5 Cir. 1963) (abandoned application necessary to carry out the provisions of the patent laws—"Congress made the public interest dominant in requiring that a patent issue only to the first inventor in fact. . . . In this connection, the [abandoned] application of Mathieu should be produced if it becomes relevant on remand. . . . Neither . . . § 122 nor the rules of the Patent Office promulgated thereunder requiring patent applications to be maintained in confidence . . . may be used to prevent the truth from coming to light . . ." 313 F.2d 46, 51); and *Carrier Mfg. Co.* v. *Rex Chainbelt, Inc.*, 281 F. Supp. 717 (E.D. Wis. 1968), and as to other forms of nonpublic evidence *Becton, Dickinson & Co.* v. *Sherwood Medical Industries, Inc.*, 516 F.2d 514 (5 Cir. 1975) and *Del Mar Engineering Labs.* v. *U. S.*, 187 U.S.P.Q. 656 (Ct. Cls. 1975).

> may consider a motion under Rule 60(b)(6) after the Court of Appeals has finished with the case. See generally, Wright and Miller, Federal Practice and Procedure, Vol. 11, Section 2873, pp. 266-270.
>
> "While such a requirement does appear to read into Rule 60(b)(6) a provision which the rules does not contain, it is also apparent that this Court may be included among those tribunals which require such leave. See, e.g. *Tribble* v. *Bruin*, 279 F.2d 424 (1960). Compare *Wilkin* v. *Sunbeam Corp.*, 405 F. 2d 165, 166 (10 Cir. 1968)."

Respondent opposed contending that this Court's decision in *Robertson* rendered petitioner's contentions "patently frivolous"—and so placed squarely in issue the conflict in decision which in fact exists between the rule in *Robertson* and the lower court decisions in this case. The opposition states:

> "In its decision of August 14, 1974, this [Fourth Circuit] Court, although not accepting the Government's broad construction of exemption 3 of the Freedom of Information Act, 5 U.S.C. 552(b)(3), held that, nevertheless, the abandoned patent applications sought by the Appellant were exempt from disclosure under exemption 3. Subsequently, in *Administrator* v. *Robertson*, 422 U.S. 255 (1975), the Supreme Court accepted the Government's construction of exemption 3 and held that all nondisclosure statutes are covered by that exemption. Since the Supreme Court gave a broader reading to exemption 3 then did this Court, the materials sought by the Appellant are, *a fortiori*, covered by exemption 3.
>
> "Significantly, the Appellant's petition for certiorari in this case was pending before the Supreme Court at the time it had *Robertson* under consideration. On June 30, 1975, six days after its decision in *Robertson*, the Supreme Court denied certiorari in this case. The Appellants thereafter filed a peti-

tion for rehearing with the Supreme Court and that was also denied.

"Under these circumstances, the Appellant's contention that the abandoned patent applications are not covered by exemption 3 is patently frivolous. Accordingly, this Court should deny the Appellant's petition to permit the filing of a Rule 60(b)(6) motion."

On December 15, 1975, the court of appeals filed a summary order stating:

"Upon consideration of the plaintiff's motion to permit the district court to consider a motion pursuant to Rule 60(b)(6), by Counsel.

"IT IS ORDERED that the motion is *denied.*" (App. 2a).

Petitioner is thus faced with a summary refusal to permit the district court *even to consider* whether its decision *conflicts* with the subsequent ruling of this Supreme Court in *Robertson.*

It is the very purpose of Rule 60(b) to prevent just such an inequitable result.

REASONS WHY THE WRIT SHOULD BE GRANTED

1. Decisions of the courts of appeal are in hopeless confusion on the question of whether appellate leave is required before the district court may consider a motion under Rule 60(b) after a court of appeals has finished with the case.

In the most recent reported opinion, the Tenth Circuit has held that appellate leave is not required. *Wilkin* v. *Sunbeam Corp.*, 405 F.2d 165, 166 (10 Cir. 1968).

The Tenth Circuit decision is in conflict with decisions from other circuits, including the Third, Fourth, Seventh and Eighth.[2]

In the Second Circuit, early opinions of Judge Clark, a draftsman of the rules, pointed out that the rules did not require appellate permission for the district court to consider the case, and held acordingly that the district court could act without permission. See *Perlman* v. *322 West Seventy-Second St. Co.*, 127 F.2d 716, 719 (2 Cir. 1942) and *S. C. Johnson & Son* v. *Johnson*, 175 F.2d 176, 177 (dissenting opinion) (2 Cir. 1949).

In 1964, the Second Circuit found it "unnecessary to consider appellant's further contention that our affirmance of the judgment precluded the District Court from taking action under that Rule [60(b)] without first obtaining leave from this Court"—albeit recognizing the *conflict* in decision which had developed in the interim. *Schildhaus* v. *Moe*, 335 F.2d 529 (1964).[3]

In 1968, in *Smith* v. *Alleghany Corp.*, 394 F.2d 381, 388, the Second Circuit stated that:

". . . It is the rule in most circuits that where the action which the district court is asked to take under Rule 60(b) would disturb the judgment ordered by the appellate court's mandate, the district court lacks power to proceed until leave is obtained. 7 Moore, Federal Practice ¶ 60.30 [2]. *This court has not yet*

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[2] See *Krock* v. *Electric Motor & Repair Co.*, 339 F.2d 73 (1 Cir. 1964); *Wilson Research Corp.* v. *Piolite Plastics Corp.*, 336 F.2d 303 (1 Cir. 1964); *Butcher & Sherrerd* v. *Welsh*, 206 F.2d 259 (3 Cir. 1953), cert. den. 346 U.S. 925; *Tribble* v. *Bruin*, 279 F.2d 424 (1960); *Geuder Paeschke & Frey Co.* v. *Clark*, 288 F.2d 1 (7 Cir. 1961), cert. den. 368 U.S. 826 (1961); *Hartman* v. *Lauchli*, 304 F.2d 431 (8 Cir. 1962).

[3] "Compare Judge Clark's views [in *Perlman* and *S.C. Johnson & Son, supra*] with the *contrary decisions* in [*Butcher & Sherrerd, Tribble, Geuder, Paeschke & Frey Co.* and *Hartman, supra*]." 335 F.2d at 531.

decided whether the rule should be established in this circuit—Judge Clark was very strongly of the view that it should not. See generally Judge Friendly's opinion in Schildhaus v. Moe, 335 F.2d 529, 530 (2 Cir. 1964). We need not resolve the question here in view of our determination on the merits."

In the Third Circuit, it was initially the rule that appellate leave is *not* required. *Von Wedel* v. *McGrath*, 100 F.Supp. 434, aff'd 194 F.2d 1013 (3 Cir. 1952).

However, in 1953, the Third Circuit in *Butcher & Sherrerd, supra* was presented with an aggravated case.

". . . It involved a persistent litigant who had previously been before the court of appeals four times, and who had 14 times sought review in the Supreme Court by means of petitions for certiorari, motions for rehearings of denials of certiorari, and applications for leave to file yet more motions for rehearing. Ultimately his persistence was rewarded when a district judge granted his motion under Rule 60 (b) to reopen the judgment.

The appellate court responded decisively. It handed down a striking opinion, loaded with quotable epigrams, in which it announced that a district judge lacks jurisdiction to grant a Rule 60(b) motion reopening a judgment that has been affirmed on appeal unless the appellate court has first given leave. It granted writs of prohibition and mandamus requiring the district judge to vacate his order allowing a new trial.

The decision just described has attracted a considerable following as other courts have held that appellate leave is required, . . ."[4] (Footnotes omitted). Wright & Miller, Vol. 11, § 2873, p. 267-8.

The conflict rages even among the text writers. The requirement of appellate leave which some circuits have

[4] Such "following" includes the cases cited in note 2, *supra*.

read into Rule 60(b) has been criticized because it "introduces into an attempted simplification of the practice for reopening judgments a useless and delaying formalism". *Wright and Miller, supra* at 269.

On the other hand Professor Moore suggests that the appellate courts could properly "screen out attacks that are clearly without merit" and grant leave if "a *prima facie* case of merit is made out" 7 Moore's Federal Practice 60.30 [2] page 341.

However, this case demonstrates that through the expedient of declaring a Rule 60(b) motion "frivolous" a court of appeals may insulate its ruling and the ruling of its district court from review and modification in light of *subsequent* and controlling decisions of this Court with which they clearly are in conflict.

This is a type of result which Rule 60(b), by its noninclusion of a leave requirement, was designed to preclude.

2. The decisions below are in conflict with the decision of this court in *Robertson.*

The rule in *Robertson* is that the duty of the courts in balancing the FOIA against each of 100 more or less statutes, including 35 U.S.C. § 122(b) which restrict access to specific Government records is to determine whether the laws are "capable of co-existence" and if so "to regard each as effective":

(a) In *Robertson,* this Court emphasized that "the [FOI] Act has two aspects" and that

". . . It is axiomatic that all parts of an act 'if at all possible, are to be given effect.'" (Citations omitted.) 45 L.Ed.2d at 170-171.

With regard to the interrelationship of the FOIA and § 1104 of the Federal Aviation Act with which it was specifically confronted, the Court said:

"Earlier this Term, Mr. Justice Brennan, speaking for the Court in the Regional Rail Reorganization Cases, 419 US 102, . . . noted that 'repeals by implication are disfavored,' id., at 133, . . . and that, when courts are confronted with statutes 'capable of coexistence, it is the duty of the courts, absent a clearly expressed congressional intention to the contrary, to regard each as effective.' Id., at 133-134, . . . quoting Morton v. Mancari, 417 US 535, 551 . . . (1974) . . ." 45 L.Ed.2d at 173.

Applying these principles, this Court determined that the FOIA and § 1104 of the FAA Act are "capable of coexistence" and discharged its "duty . . . to regard each as effective."

The decisions below fail to give effect to important parts of both the FOIA and 35 U.S.C. § 122, notwithstanding the fact that these two statutes are clearly capable of coexistence. Instead of discharging the courts' "duty . . . to regard each as effective", these opinions—in *conflict* with the rule in *Robertson* hold that exemption 3 repeals by implication that provision of § 122 that mandates public availability of "applications for patents" that are "necessary to carry out the provisions of any Act of Congress".

(b) One of the "two aspects" of the FOIA "seeks to open public records to greater public access",[5] while "the other . . . seeks to preserve the confidentiality undeniably essential in certain area of Government operations".[6] *Robertson, supra*, 45 L.Ed.2d at 170-171.

§ 122 has two like aspects. In one, it seeks to open to the public those patent applications as to which *exclusion* from "confidence" is "necessary to carry out

[5] I.e., the disclosure provisions of § 552(a).

[6] I.e., by the "nine explicitly exclusive exemptions", 45 L.Ed.2d at 171.

the provisions of any Act of Congress"; in the other, it seeks to preserve in confidence all applications not so "necessary" and as to which the Commissioner has not determined that "special circumstances" warrant disclosure.

Thus, 35 U.S.C. § 122 provides:

"Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner *unless*

[1] *necessary* to carry out the provisions of any Act of Congress, *or*

[2] in such special circumstances as may be determined by the Commissioner." (Paragraphing and bracketed material added.)

The disclosure aspect of § 122 is concerned with those applications "*necessary to carry out the provisions of any Act of Congress*". The applications in this category are expressly *excluded* from its "confidence provisions" by § 122's own terms. "The wisdom of the balance struck by Congress is not open to judicial scrutiny." *Robertson, supra*, 45 L.Ed.2d at 174.

Under the rule in *Robertson* these records, accordingly, cannot be subjected to exemption 3. Instead, the disclosure provisions of the FOIA, § 552(a), apply directly to require that all such applications be "produced on demand". *NLRB* v. *Sears, Roebuck & Co.*, 421 U.S. 132, (1975).[7]

[7] The nondisclosure aspect of § 122 is concerned with applications outside the disclosure categories [1] and [2], defined by § 122, *i.e.*, all those applications *which are not* "necessary to carry out the provisions of any Act of Congress", *and* which the Commissioner does not "determine" to be subject to "such special circumstances" as to warrant disregard of § 122's confidence provisions. Only the applications remaining "shall be kept in confidence" by the Commissioner, and "no information concerning the same shall be given without authority of the applicant or owner".

The conflict in decision is significant. As will be seen, it is now used by the Patent Office as justification for a refusal to discharge its duty under 35 U.S.C. § 131 to grant patents only after a proper "search" and then only where "after examination it appears that the applicant is entitled to a patent under the law".

In a different context, the Department of Justice has contended with apparent success in this case that *Robertson* "held that all nondisclosure statutes are covered by that exemption [3]"—thus ignoring the mandate of this Court that the FOIA and the nondisclosure statutes wherever possible are to be so construed as to be "capable of coexistence" with each "regard[ed] as effective."

3. The decision of the Fourth Circuit Court of Appeals rejecting petitioner's Rule 60(b) motion as "frivolous" condones the refusal of the Patent Office, in the discharge of its duty under 35 U.S.C. § 131, to consider nonpublic evidence in determining whether "under the law" including 35 U.S.C. § 103, a patent "shall issue" on applications pending before it.

The decision below thus endorses the *basic conflict* between the Patent Office and the federal courts as to whether such evidence is "necessary to carry out the provisions of any Act of Congress", 35 U.S.C. § 122, to wit, the patent laws including 35 U.S.C. § 103.

In the federal courts, *including this Court*, such evidence *is* considered "necessary" and is routinely admitted and weighed in adjudicating the validity of patents. See the cases cited *supra*, p. 7, n. 1.

However, the Patent Office refuses to consider such evidence. The result is that "a significant number of patents have been and are being granted for trivial innovations".[8] The result is "the sagging reputation of

[8] *Marquis*, "Improving Quality Control for Patents," Minn. L. Rev. 59, *67* (1974).

the patent system", *ibid.* and the burdening of the courts with a mass of complex cases that "seem to take an inordinate amount of trial time" and which are therefore "unquestionably expensive". *Blonder-Tongue Labs* v. *Univ. of Ill. Foundation*, 402 U.S. 313, 337 (1971).

The Commissioner is *now affirmatively using the decision below* as justification for his disdain of this Court's admonition in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966) that

> "the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system"

and for the concomitant perpetuation of the dichotomy between judicial and administrative patentability standards which this Court has twice criticized. *Graham, supra; Kewanee, supra.*

Exhibit A hereof (*infra*, p. 3a) is a copy of a letter from Lee Pharmaceuticals to the defendant Commissioner of Patents calling attention to the dichotomy between the Patent Office and the courts with respect to the consideration of nonpublic evidence on the issue of patentability. The letter is in the nature of a request under the Freedom of Information Act as follows:

> "At present, my company has a unique commercial product constituting a carvable dental composite restorative material covered by Application Serial No. 504,838. I am writing this letter to request that the Patent Office search for and make available to my company under 5 U.S.C. 552(a)(3) those abandoned patent applications that *may* be in any way germane, based on their subject matter, to the patentability under any section of the patent statutes of the claims of Application Serial No. 504,838—and that those claims be evaluated relative to all abandoned patent applications so located."

Exhibit B (*infra*, p. 5a) is the defendant Commissioner's initial rejection of Lee Pharmaceuticals' request.

Exhibit C (*infra*, p. 7a) is Lee Pharamaceuticals' appeal from the initial rejection of its request (Exhibit B).

Exhibit D (*infra*, p. 10a) is the "final decision for the Department of Commerce" dated December 1, 1975 rejecting Lee Pharmaceuticals' request on the following grounds:

> "Congress has directed that '[a]pplications for patent shall be kept in confidence by the Patent [and Trademark] Office and no information concerning the same given without authority of the applicant or owner * * *.' 35 USC 122. The U. S. District Court for the Eastern District of Virginia has held in Sears v. Gottschalk, 357 F.Supp. 1327, that abandoned patent applications are barred from disclosure by 35 USC 122, and therefore specifically exempted by statute from disclosure under the Freedom of Information Act, as provided in 5 USC 552(b)(3). The Court's decision was affirmed by the U. S. Court of Appeals for the Fourth Circuit (502 F.2d 122). Certiorari was denied by the Supreme Court on June 30 of this year (sub nom. Sears v. Dann) and rehearing was denied on October 6.
>
> "I cannot agree with your contention that my duty to 'cause an examination to be made' of patent applications (35 USC 131) requires me to consider abandoned patent applications as references. The same contention was made, and rejected by the Court, in Sears v. Gottschalk, supra.
>
> "The two cases cited in your original request (Del Mar Engineering Laboratories v. United States, 186 USPQ 42 (Ct. Cls. 1975), and Becton, Dickinson v. Sherwood, 187 USPQ 200 (5th Cir. 1975)) did not involve the use of abandoned patent applications as references.

> "I cannot agree with your view that the exemption of abandoned applications from disclosure conflicts with the Supreme Court's decision in Administrator, FAA v. Robertson, 422 U.S. 255, 95 S.Ct. 2140. *The same contention was recently made by the plaintiff in the Sears case* and rejected by the Court in denying the plaintiff's motion under Rule 60(b), FRCP, for relief from judgment (E.D. Va., November 14, 1975)." (Emphasis added.)

CONCLUSION

The petition should be granted.

Respectfully submitted,

EDWARD S. IRONS
1801 K Street, N.W.
Washington, D.C. 20006
296-8855

Attorney for Petitioner

APPENDIX

APPENDIX A

DECISION BY THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA ALEXANDRIA DIVISION

November 14, 1975

"THE COURT: . . . I don't think I have jurisdiction; I think it's improperly filed. I'll dismiss it for that reason."

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

73-1699

MARY HELEN SEARS,
Appellant,

vs.

ROBERT GOTTSCHALK, Commissioner of Patents,
Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA, AT ALEXANDRIA.

Upon consideration of the plaintiff's motion to permit the district court to consider a motion pursuant to rule 60(b)(6), by counsel,

IT IS ORDERED that the motion is denied.

For the Court—by Direction

/s/ WILLIAM K. SLATE, II
Clerk

Filed: December 15, 1975

[SEAL]

EXHIBIT A

LEE PHARMACEUTICALS

1444 Santa Anita Ave., P.O. Box 3836
South El Monte, Calif. 91733
(213) 442-3141

September 9, 1975
HL 75-441

Mr. Joseph Nakamura
Solicitor, United States Patent Office
Washington, D.C. 20230

Dear Mr. Nakamura:

I am writing you as President of Lee Pharmaceuticals and a named inventor on many of its patents and patent applications, to express my dismay that abandoned patent applications in the Patent Office files are not publicly available to be searched before a patent application is filed and are not used in examining patent applications after they are filed. This is particularly difficult for me to rationalize with what I understand to be the fact that such abandoned applications *are* considered by the courts as evidence that may invalidate an issued patent. In this connection, I have noted the recent use of non-public evidence to invalidate patents in *Del Mar Engineering Laboratories* vs *United States* 186 USPQ 42 (Ct. Cls. 1975) and in *Becton, Dickinson & Co.* vs *Sherwood Medical Industries, Inc.*, No. 72-3599 decided by the Fifth Circuit Court of Appeals July 28, 1975.

At present, my company has a unique commercial product constituting a carvable dental composite restorative material covered by Application Serial No. 504,838. I am writing this letter to request that the Patent Office search for and make available to my company under 5 U.S.C. 552(a)(3) those abandoned patent applications that *may* be in any way germane, based on their subject

matter, to the patentability under any section of the patent statutes of the claims of Application Serial No. 504,838—and that those claims be evaluated relative to all abandoned patent applications so located.

I look forward to your prompt response.

Very truly yours,

/s/ Henry Lee
HENRY LEE, Ph.D.
President

HL:lm

EXHIBIT B

[SEAL]

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

September 30, 1975

Dr. Henry Lee
President, Lee Pharmaceuticals
1444 Santa Anita Avenue
P.O. Box 3836
South El Monte, Calif. 91733

Dear Mr. Lee:

This is in response to your letter of September 9, 1975, received on September 16, 1975, requesting that the Patent and Trademark Office search for and make available to your company under 5 USC 552(a)(3), those abandoned applications that may be germane to the patentability of claims in application Serial No. 504,838.

I regret that your request must be denied. There are literally hundreds of thousands of abandoned patent applications in the Patent and Trademark Office. An unreasonable amount of effort would be involved in locating any which might be germane to the patentability of claims in application Serial No. 504,838. And even if any were located, we would be prohibited by statute, 35 USC 122, from making them available to your company. The noted statute specifies that "[a]pplications for patents shall be kept in confidence by the Patent Office * * *." 35 USC 122. Abandoned applications, accordingly, are exempt from disclosure. 5 USC 552(b)(3).

You also request an evaluation of the claims in application Serial No. 504,838, relative to all abandoned patent

applications located. This request is likewise denied since 5 USC 552(a)(3) applies only to existing records and does not require an agency to create a record.

Should you desire to do so, you may submit a written appeal from this decision within 30 calendar days after the date of this letter. The appeal shall include a copy of your original request, a copy of this letter and a statement of the reasons why you believe this denial is in error. The appeal should be addressed to The Commissioner of Patents and Trademarks, Freedom of Information Request Control Desk, Box 50, Washington, D.C. 20231.

Sincerely,

/s/ Joseph F. Nakamura
JOSEPH F. NAKAMURA
Solicitor

cc: Asst. Gen. Counsel for Admin.

EXHIBIT C

[SEAL]

LEE PHARMACEUTIALS

1444 Santa Anita Ave., P.O. Box 3836
South El Monte, California 91733 U.S.A.
Tel. (212) 442-341 WATS: (800) 423-4173
TWX: (910) 587-3420

October 29, 1975

Mr. Joseph Nakamura
Solicitor, United States Patent Office
Washington, D.C. 20230

Dear Mr. Nakamura:

This a written appeal from the decision which appears in the September 30, 1975 letter signed by Joseph F. Nakamura, Solicitor. A copy of my original request dated September 16, 1975 and of Mr. Nakamura's September 30, 1975 letter are enclosed.

The reasons why I believe Mr. Nakamura's denial of my request is in error include the following:

1. As my original request points out non-public evidence, including abandoned patent applications, are considered by the courts as evidence that may invalidate patents for failure to measure up to the constitutional patentability standard as embodied, for example, in 35 U.S.C. 103. Mr. Nakamura does not suggest otherwise.

2. 35 U.S.C. 6 provides that the Commissioner . . . shall superintend or perform all duties required by law respecting the granting and issuing of patents".

As a part of his duties the Commissioner is required to "cause an examination to be made" of each application for patents and of "the alleged new

invention" contained therein and to issue a patent on such applications only "if on such examination it appears that the applicant is entitled to a patent under the law" 35 U.S.C. 131.

3. To determine whether the "applicant is entitled to a patent under the law" it is necessary for the Commissioner to consider the evidence germane to that issue which is contained in abandoned patent applications.

My request that the Commissioner discharge that duty as to my company's application 504,838—a duty which is imposed by the patent statutes—is not rationally denied by Mr. Nakamura's observation that "5 U.S.C. 552(a)(3) . . . does not require an agency to create a record".*

4. Since, as demonstrated by paragraphs 2 and 3, availability and consideration of abandoned applications is "necessary to carry out the provisions of "an Act of Congress" such records are excluded from the confidence provisions of § 122—and are expressly subject to the *non discretionary* disclosure portions of that statute.

5. Mr. Nakamura's conclusion that under 35 U.S.C. 122 and 5 U.S.C. (b)(3) abandoned applications are "exempt from disclosure" conflicts squarely with *Administrator, F.A.A.* v. *Butterfield* 422 U.S. 255, 45 L.Ed. 2d 165 (1975).

As explained in that decision, "all parts of an act . . . are to be given effect" and "repeals by implication" are not favored. Statutes capable of coexistence are to be construed to give effect to both

* Notably my request was that abandoned applications which are "germane" be considered in connection with my application Serial No. 504,838—just as all other germane references are considered.

or all. Both the FOIA and § 122 have disclosure and nondisclosure aspects. Both aspects of both acts can and should be given effect.

The disclosure aspect of § 122 is concerned with those applications "necessary to carry out the provisions of any Act of Congress". The applications in this category are expressly excluded from its "confidence provisions" by § 122's own terms. "The wisdom of the balance struck by Congress is not open to judicial scrutiny." Robertson, supra, 45 L. Ed. 2d at 174.

Very truly yours,

/s/ Henry Lee
HENRY LEE, Ph.D.
President

HL/rcw
enclosures

EXHIBIT D

[SEAL]

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Address Only: COMMISSIONER OF PATENTS AND
TRADEMARKS
Washington, D.C. 20231

December 1, 1975

Dr. Henry Lee
President, Lee Pharmaceuticals
1444 Santa Anita Avenue
P.O. Box 3836
South El Monte, California 91733

Re: Appeal from initial decision
denying a request under the
Freedom of Information Act

Dear Dr. Lee:

This is in response to your letter of October 29, 1975, appealing from the denial of your request to have the Patent and Trademark Office search for and make available to your company under the Freedom of Information Act, 5 USC 552, those abandoned patent applications that may in any way be germane to patentability of the claims in your pending patent application. You had also requested, and been denied, an evaluation of the claims in the light of all abandoned applications so located.

I have reviewed the reasons why you believe the denial of your request was in error but am not convinced that the denial was wrong.

Congress has directed that "[a]pplications for patent shall be kept in confidence by the Patent [and Trade-

mark] Office and no information concerning the same given without authority of the applicant or owner * * *." 35 USC 122. The U.S. District Court for the Eastern District of Virginia has held in *Sears* v. *Gottschalk*, 357 F. Supp. 1327, that abandoned patent applications are barred from disclosure by 35 USC 122, and therefore specifically exempted by statute from disclosure under the Freedom of Information Act, as provided in 5 USC 552(b)(3). The Court's decision was affirmed by the U.S. Court of Appeals for the Fourth Circuit (502 F.2d 122). Certiorari was denied by the Supreme Court on June 30 of this year (*sub nom Sears* v. *Dann*) and rehearing was denied on October 6.

I cannot agree with your contention that my duty to "cause an examination to be made" of patent applications (35 USC 131) requires me to consider abandoned patent applications as references . The same contention was made, and rejected by the Court, in *Sears* v. *Gottschalk, supra.*

The two cases cited in your original request (*Del Mar Engineering Laboratories* v. *United States*, 186 USPQ 42 (Ct. Cls. 1975), and *Becton, Dickinson* v. *Sherwood*, 187 USPQ 200 (5th Cir. 1975)) did not involve the use of abandoned patent applications as references.

I cannot agree with your view that the exemption of abandoned applications from disclosure conflicts with the Supreme Court's decision in *Administrator, FAA* v. *Robertson*, 422 U.S. 255, 95 S. Ct. 2140. The same contention was recently made by the plaintiff in the *Sears* case and rejected by the Court in denying the plaintiff's motion under Rule 60(b), FRCP, for relief from judgment (E.D. Va., November 14, 1975).

Finally, your request that an evaluation of the claims in your pending application be made is a request to have a record (evaluation) made. The Freedom of In-

formation Act does not require agencies to create a record, and your request was, therefore, properly denied.

I am, therefore, finally denying your Freedom of Information Act request on the ground that the requested records fall within the (b)(3) exemption of the Act and the requested evaluation is not within the scope of the Act. This is a final decision for the Department of Commerce from which you have a right of judicial review as specified in 5 USC 552(a)(4)(B).

Sincerely,

/s/ C. Marshall Dann
C. MARSHALL DANN
Commissioner of Patents and Trademarks

cc: Special Asst. to the Secretary
for Public Affairs
Asst. Secretary for Administration
Asst. General Counsel for Administration